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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/598,134	06/21/2000	Eric Schneider		7196

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EXAMINER

COULTER, KENNETH R

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 03/11/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/598,134

Applicant(s)

SCHNEIDER, ERIC

Examiner

Kenneth R Coulter

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 1 Page 2 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 28 - 47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 21 of U.S. Patent No. 6,338,082. Although the conflicting claims are not identical, they are not

Art Unit: 2141

patentably distinct from each other because both the present Application and U.S.

Patent No. 6,338,082 disclose a method for processing a request having one or more search terms comprising:

one of a receiving or generating at least one domain name from the one or more search terms;

retrieving at least one search result corresponding to the one or more search terms; and

determining whether said at least one domain name is available for registration either one of a before, during, or after providing said at least one retrieved search result.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 28 - 47 are rejected under 35 U.S.C. 102(e) as being disclosed by

Broadhurst (U.S. Pat. No. 6,560,634) (Method of Determining Unavailability of an Internet Domain Name).

4.1 Regarding claim 28, Broadhurst discloses a method comprising:

one of a parsing and generating an internet search engine request to search internet content from one or more identifiers (Abstract; Fig. 4; col. 6, lines 15 – 26; col. 4, lines 10 - 22);

performing an internet content search in accordance with said internet search engine request (Abstract; Fig. 4; col. 6, lines 15 – 26; col. 4, lines 10 - 22);

retrieving at least one search result from said internet content search (Abstract; Fig. 4; col. 6, lines 15 – 26; col. 4, lines 10 - 22);

one of a parsing and generating at least one domain name from the one or more identifiers (Abstract; Fig. 4; col. 6, lines 15 – 26; col. 4, lines 10 - 22); and

determining whether said at least one domain name is available for registration either one of a before, during, and after presenting said at least one search result from said internet content search (Abstract; Fig. 4; col. 6, lines 15 – 26; col. 7, lines 9 - 26).

4.2 Per claim 29, Broadhurst teaches that said at least one domain name is one of a valid domain name and fictitious domain name (Abstract; Fig. 4; col. 6, lines 15 – 26; col. 4, lines 10 - 22).

4.3 Regarding claim 30, Broadhurst discloses including providing a registration form for all domain names that are determined available for registration and providing registrant information for all domain names that are determined not available for registration (Abstract; Fig. 4; col. 6, lines 15 – 26; col. 7, lines 9 - 26).

Art Unit: 2141

4.4 Per claims 31 – 37, Broadhurst teaches a registration form (Fig. 6c); a template (Fig. 6c); hyperlinks (col. 6, lines 15 – 26; col. 7, lines 9 – 26); WHOIS information (Fig. 4, item 422; col. 6, lines 27 – 43); and text boxes (Figs. 5A, 5B).

4.5 Regarding claims 38 – 47, the rejection of claims 28 – 37 (paragraphs 4.1 – 4.4 above) under 35 USC 102(e) applies fully.

5. Claims 28 – 47 rejected under 35 U.S.C. 102(e) as being disclosed by Belfiore et al. (U.S. Pat. No. 6,009,459) (Intelligent Automatic Searching for Resources in a Distributed Environment).

5.1 Regarding claim 28, Belfiore discloses a method comprising:

one of a parsing and generating an internet search engine request to search internet content from one or more identifiers (Abstract);

performing an internet content search in accordance with said internet search engine request (Abstract “If a valid URL cannot be constructed, the browser then automatically formats a search engine query using the user-entered text and forwards the query to an Internet search engine”);

retrieving at least one search result from said internet content search (Abstract);

one of a parsing and generating at least one domain name from the one or more identifiers (Abstract “If the user enters text that is not a URL, the system may first try to construct a valid URL from the user-entered text.”); and

determining whether said at least one domain name is available for registration either one of a before, during, and after presenting said at least one search result from said internet content search (Abstract).

5.2 Per claim 29, Belfiore teaches that said at least one domain name is one of a valid domain name and fictitious domain name (Abstract).

5.3 Regarding claim 30, Belfiore discloses including providing a registration form for all domain names that are determined available for registration and providing registrant information for all domain names that are determined not available for registration (Fig. 4, item 60).

5.4 Per claims 31 – 37, Belfiore teaches a registration form (Fig. 4); a template (Fig. 12; col. 3, line 67 – col. 4, line 7); hyperlinks (Fig. 9; col. 4, lines 3 - 7); and text boxes (Fig. 4).

5.5 Regarding claims 38 – 47, the rejection of claims 28 – 37 (paragraphs 5.1 – 5.4 above) under 35 USC 102(e) applies fully.

Response to Arguments

Applicant's arguments filed 12/24/03 (Amendment B; paper #6) have been fully considered but they are not persuasive.

Applicant states that Broadhurst does not in any way teach or suggest a relationship or combination regarding performing such domain name requests while performing Internet search engine requests for Internet content, and vice-versa.

Examiner disagrees.

Broadhurst is searching small portions of the Internet, namely multiple domain name records.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

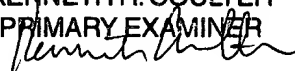
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R Coulter whose telephone number is 703 305-8447. The examiner can normally be reached on 5 4 9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 703 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KENNETH R. COULTER
PRIMARY EXAMINER



krc